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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,141	08/03/2001	Hiroshige Kikuchi	500.40416X00	6408

20457 7590 10/05/2004

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EXAMINER
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JASMIN, LYNDIA C

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/921,141

Applicant(s)

KIKUCHI ET AL. *ST*

Examiner

Lynda Jasmin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Claims are replete with errors. Some examples follow:

In claim 1, the recitations "the data exhibiting" and "the work situation" in lines 5 and 6, lack proper antecedent basis.

In claim 2, the recitation "the work situation" in line 6, lacks proper antecedent basis.

In claim 4, the recitations "the data relating" and "the work situation" in lines 6 and 7, lack proper antecedent basis.

In claim 5, the recitation "the consumed electric power rate" lacks proper antecedent basis. Same as in claim 6 and claim 8.

In claim 9, the recitations "the maintenance diagnosis" and "the replacement diagnosis" in lines 3 and 4, lack proper antecedent basis.

In claim 10, the recitation "the electric power rate" in line 4, lacks proper antecedent basis.

In claim 16, the recitations "the data relating", "the situation" and "the half-way progress" at lines 3 and 4, lack proper antecedent basis. Same as in claim 17.

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In claim 18, the recitations "the arithmetic operation" and "the fixed amount" in lines 3 and 7, lack proper antecedent basis.

In claim 19, the recitations "the basis", "of the work result data", the judgment of abnormally", "on the basis of the judgment result" and "the maintenance needs" lack proper antecedent basis.

In claim 20, the recitations "the total cost", "the scrapping processing", and "the replacement judgment" lack proper antecedent basis.

In claim 16, the recitation "can send the data relating to the situation of the half-way progress of use of the electric power to said electric appliance" is unclear, thus renders the claim indefinite.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Yabutani et al. (6,775,595 B1). As best understood, Yabutani et al. discloses an electric appliance renting system having electric appliance communicating with a server through a communication line (col. 3, lines 50-55), and is rented out inclusively of an electric

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power rate where a rental manager server include means for calculating a charge which is to be paid to the electric power supplying company (col. 4, lines 40-52).

5. Applicants are reminded, "in general, a preamble limits the invention if it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim. Conversely, a preamble is not limiting where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention." *Catalina Marketing International Inc. v. Coolsavings.com Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1784-85 (Fed.

Cir. 2002) (Citations and quotations omitted).<sup>1</sup> In this case, it is the Examiner's position that the preamble in claims 1, 2, and 4 and is not necessary to give life, meaning, and vitality to the claim. Specifically, Applicant(s) recite the intended use of their system, "in which for a use contractor who has made a contract with a service providing company leases an electric appliance rented out from said service providing company." Because Applicant(s) recite in their preamble that the claim is "for" doing this, "for" doing that, and "for" doing a third activity, the Examiner interprets those phrases as stating the intended *use* or intended *result* of the claimed system.

Further, It is well known that the Applicants are free to recite features of an apparatus either structurally or functionally. *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971). It is the Examiners position that the limitations "can

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<sup>1</sup> See also *Allen Engineering Corp. v. Bartell Industries Inc.*, 299 F.3d 1336, 1346, 63 USPQ2d 1769, 1774 (Fed. Cir. 2002) ("Generally, the preamble does not limit the claims. However, the preamble may be limiting when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention. If the preamble is necessary to give life, meaning and vitality to the claim, then the claim preamble should be construed as limiting. This is determined on the facts of each case in view of the claimed invention as a whole.")

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send" and "can received" are functional or intended use language. However, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the function or intended use, then it meets the claim. *In re Casey*, 370 F.2d 576, 152 USPQ 235, 238 (CCPA 1967).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kao et al. discloses a system for controlling the use of electrically powered devices. Sakaguchi discloses a network system that is in communication with home appliance and utilizes the data collected from the home appliances. Michaels discloses a method for billing for consumption via a communication line. Mise discloses a method and system for supervising various customer services offered to a contractor. Kende et al. discloses a system and method for analyzing rate for service.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 9/30/04  
Lynda Jasmin  
Primary Examiner  
Art Unit 3627

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